

EST



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,466	03/27/2001	Sean Lee	099866/9	1836
31013	7590	03/01/2006	EXAMINER	
KRAMER LEVIN NAFTALIS & FRANKEL LLP INTELLECTUAL PROPERTY DEPARTMENT 1177 AVENUE OF THE AMERICAS NEW YORK, NY 10036			SHEIKH, HUMERA N	
			ART UNIT	PAPER NUMBER
			1615	

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/818,466	Applicant(s) LEE ET AL.	
	Examiner Humera N. Sheikh	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 135-170 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 135-170 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Humera N. Sheikh
HUMERA N. SHEIKH
PATENT EXAMINER
TC-1600

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of the Application

Receipt of the Request for Continued Examination (RCE) under 37 CFR 1.114, Applicant's Arguments/Remarks and the request for extension of time (3 months-granted), all filed 12/05/05 is acknowledged.

Claims 135-170 are pending in this action. No amendments to the claims have been made. Claims 135-170 are rejected.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/05/05 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1615

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 135-138 and 153-156 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaTorre *et al.* (US Pat. No. 6,517,863 B1).

The instant invention is drawn to a cosmetic composition comprising bioactive glass and a substantially anhydrous cosmetic formulation with the proviso that said bioactive glass does not comprise ions of silver, copper or zinc.

LaTorre *et al.* ('863) teach compositions and methods for treating nails and adjacent tissues comprising particles of bioactive glass that have anti-microbial properties, alone or in combination with therapeutic agents, hydrophilic polymers and other additional agents (see Abstract).

According to LaTorre *et al.*, the bioactive glass composition can be prepared in several ways to provide melt-derived glass, sol-gel derived glass, and sintered glass particles (col. 4, lines 33-45). The bioactive glass has a particle size of less than about 5 microns and can be in the form of a suspension, lotion, cream (water-in-oil emulsion), gel or extract (col. 4, lines 27-32; 51-67).

LaTorre *et al.* disclose that the bioactive glass compositions can include additional components, such as antibiotics, antivirals, antifungals, biotin, collagen, amino

Art Unit: 1615

acids, proteins, vitamins, penetration enhancers, permeation/binding agents, dyes, fragrances and other cosmetically useful additives (col. 2, lines 62-66). Bioactive glass also has anti-microbial properties (col. 2, line 67).

The Examples at columns 6-7 demonstrate various bioactive glass formulations for application to a nail surface. For instance, Example 1 at column 6, line 45 demonstrates a bioactive glass preparation whereby 0.2 grams of Bioglass® with a particle size of less than 20 microns was mixed with an equal volume of water to form a paste. The paste was applied to the nails of one hand and allowed to dry. This procedure was repeated and after two applications of the Bioglass® powder, there was a discernable difference in the strength and hardness of the nails treated with the Bioglass® powder, compared to the untreated control.

Claims 139-152 and 157-170 are rejected under 35 U.S.C. 103(a) as being unpatentable over LaTorre *et al.* (US Pat. No. 6,517,863 B1) as applied to claims 135-138 and 153-156 above and further in view of Vatter *et al.* (US Pat. No. 6,224,888 B1).

The teachings of LaTorre *et al.* ('863) have been discussed above. LaTorre *et al.* do not teach cosmetic additives, such as jojoba oil, glycerin, parabens and pigments. It is obvious to one of ordinary skill in the cosmetic art to include additives, such as oils, waxes, pigments and the like. Such skill is also evident from the reference of Vatter *et al.*

Vatter *et al.* ('888) teach cosmetic compositions comprising various additives, such as oils, waxes, pigments, preservatives, colorants, fragrances and the like. Suitable

Art Unit: 1615

oils include *jojoba oil, mineral oil, castor oil, etc.* (see reference column 6, lines 19-35). Waxes include *carnauba, candelilla, ozokerite, microcrystalline waxes and mixtures thereof* (col. 8, lines 31-44). *Pigments, dyes and talc* are disclosed at column 10, line 64-col. 11, line 49. Vitamins taught include *Vitamin A and E* (col. 12, lines 20-29). *Glycerine* is disclosed at column 5, lines 8-13. Parabens, such as *methyl paraben and propyl paraben* are disclosed in various examples, particularly Example 14. Vatter *et al.* teach that the cosmetic compositions can be, for instance, in the form of foundations, eye shadows, blushers, lipstick, lipcare products, mascara, solutions, powders and the like (col. 2, lines 16-21); (col. 12, lines 2-35).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the various additives of Vatter *et al.* within the cosmetic composition of LaTorre *et al.* because Vatter *et al.* expressly teach cosmetic compositions comprising routinely utilized additives (*i.e.*, oils, waxes, pigments, vitamins, preservatives for skin/hair/nails) and teach that such additives are suitable and beneficial for use in personal care compositions. The expected result would be an enhanced, beneficial cosmetic composition for use in personal care applications.

Therefore, it is the position of the Examiner, that given the teachings of the prior art delineated above, whereby the prior art explicitly teaches cosmetic formulations comprising bioactive glass and teaches commonly employed cosmetically-formulated additives in a variety of make-up products, the instant invention, when taken as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Pat. No. 4,814,165 Berg *et al.* 03/1989

Response to Arguments

Applicant's arguments filed 12/05/05 have been fully considered, but they were not found persuasive.

1. 35 U.S.C. §103(a) rejection of claims 135-138 and 153-156 over LaTorre et al. (USPN 6,517,863):

Applicant argued the following: "LaTorre is directed to compositions and methods for hardening and strengthening nails. In sharp contrast, the present invention is directed to long-lasting cosmetic preservative compositions comprising bioactive glass and a substantially anhydrous cosmetic formulation (and methods of making the same)."

Applicant's arguments were not found persuasive. Examiner notes that LaTorre's nail treating composition, which comprises bioactive glass, is also, in fact, a cosmetic composition, which provides for preservative qualities and effects, as similarly desired by Applicants. The compositions of LaTorre are comprised of the same components, used in the same field of endeavor as the Applicant's bioactive glass cosmetic composition. Thus, LaTorre's compositions would also provide for beneficial results, since similar components are employed therewith.

Applicant argued, "LaTorre uses the word 'optional' to describe certain compositions, however the reference shows that all of the functional compositions require an aqueous base and are not long-lasting."

Applicant's arguments were not found persuasive. The term 'optional' as defined in *Merriam Webster's Collegiate Edition, Tenth Edition (1999)*, is defined as "involving an option; not compulsory". Applicant's argument that "all of the functional compositions require an aqueous base" is not persuasive since the prior art's teachings are not limited to the functional examples demonstrated therein. The prior art clearly recognizes that the use of aqueous components is 'optional'. Moreover with regards to 'long-lasting' effects argued by Applicant, the Examiner points out that the compositions of LaTorre comprise bioactive glass and thus comprise components that impart preservatory attributes, rendering the compositions of LaTorre 'long-lasting'.

Applicant argued, "LaTorre does not disclose, teach or suggest the cosmetic compositions or methods of making cosmetic compositions which (1) provide a long duration of effectiveness; (2) are substantially anhydrous; and (3) do not require additional anti-microbial agents. LaTorre does not disclose stable cosmetic compositions comprising bioactive glass and a substantially anhydrous cosmetic formulation. LaTorres stresses the criticality of using aqueous solutions or hydrophilic polymers for the nail hardening compositions to work. LaTorre concedes the need for additional antimicrobials to provide a significant antimicrobial effect even in the context of nail hardening and strengthening compositions intended for immediate use."

Applicant's arguments were not found persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (*i.e.*, stability; long-lasting effects) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re*

Art Unit: 1615

Van Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). With regard to the argument that the instant claims ‘do not require additional anti-microbial agents’, it is noted that LaTorre also recognizes that antimicrobial agents ‘can’ be included; demonstrating that antimicrobials are an ‘optional’ component, not compulsory to their cosmetic compositions. Additionally, LaTorre teach that bioactive glass initially has antimicrobial properties (col. 2, lines 62-67). Applicant’s arguments directed to the instant cosmetic composition being ‘substantially anhydrous’ is not persuasive, since as delineated above, LaTorre does teach that aqueous or hydrophilic components are optional in their compositions (see Abstract).

2. 35 U.S.C. §103(a) rejection of claims 139-152 and 157-170 over LaTorre et al. (USPN 6,517,863) in view of Vatter et al. (US Pat. No. 6,224,888 B1):

Applicant argued, “Applicants maintain that claims 139-152 and 157-170 are not rendered obvious by LaTorre in view of Vatter.”

Applicant’s arguments were not found persuasive. Vatter was relied upon to demonstrate the routine use of additives (*i.e.*, oils, waxes, pigments, vitamins, preservatives for skin/hair/nails) in cosmetic compositions. Thus, Vatter sufficiently remedies this deficiency of LaTorre, by their teaching that such additives are suitable and beneficial for use in personal care compositions.

Thus, absent a clear demonstration of some unexpected results or patentable distinction over the cited art or record, the instant invention, when taken as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday through Friday from 8:00A.M. to 5:30P.M., alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Humera N. Sheikh

Patent Examiner

Art Unit 1615

February 20, 2006



TC-1600